

### **REMARKS**

The Examiner's comments together with the cited references have been carefully studied. Favorable reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

Claims 1 and 3-40 are pending in the application. Claims 16-20 and 22-38 are withdrawn from consideration. Claims 1, 3-15, 21, 39, and 40 have been rejected. New claims 41 and 42 have been added. Therefore, claims Claims 1, 3-15, 21, and 39- 42 are presently active. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

New Claims 41 and 42 has been added to recite that the microvoided layer is the product of stretching in the longitudinal and transverse directions at a draw ratio of greater than 3 or at least about 3.3 such that the area ratio between the non-stretched and the biaxially stretched film is greater than 10 or at least about 11 times. Support for these amendments is to be found in Example 3, on page 19, line 28, in which the stretch ratio in each direction is 3.3. The resulting area would thereby be  $3.3 \times 3.3 = 10.9$  or 11 to two significant figures, which "11" would include 10.6 to 11.4 by conventional use of significant figures. It is noted that Morita et al. specifies a range of stretching of 1.1 to 10 times, consistent with the examples in Morita et al., page 5, lines 27-30.

Relying on 35 U.S.C. 102(b), the Examiner has rejected claims 1, 3-15, 39, and 40 as being anticipated by Morita et al.

Applicants respectfully traverse the Examiner's rejection. The present invention is directed to "an inkjet recording element." Morita et al. is directed to a porous film useful for leak proof films for sanitary materials such as a diaper. Applicants' position is that an inkjet recording element is not a diaper; or rather a diaper is not an inkjet recording element, contrary to the Examiner's arguments. Applicants consider this distinction to be a key aspect of the present invention.

Responsive to the Examiner's arguments, Applicants take the position that running a diaper through an inkjet printer represents malfunction rather than anticipation. Nor is an inkjet recording element inherent in a diaper. Finally, words

in the claims such as “inkjet recording element,” “ink absorption rate,” and “ink-receiving layer” should be given their common sense meaning in reality.

The Examiner states that “many of the instantly claimed properties inherently result from practice of the prior art within its disclosed properties.” [emphasis added] However, the relevant issue to anticipation is whether all of the instantly claimed properties inherently result from practice of the prior art. Moreover, Applicants can say with perfect certainty, by a cursory perusal of the Examples in Morita et al., that it is obvious that all of the examples in Morita inherently do not result in Applicants’ claimed invention nor have the claimed properties.

Applicants are not claiming a combination of selections from various lists in the prior art but are claiming a product, namely “an inkjet recording element” composed of a particular material, characterized by interconnecting voids enabling capillary action and having a certain adsorption rate and microvoid volume percent. Accordingly, the Applicants request the Examiner to identify the particular product or example in Morita et al. that anticipates Applicants’ invention and explain the reasons for selecting that particular product or example.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. 102(b).

Claims 1, 3-15, 21, 39, and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al.

It is the conclusion of the Examiner that “...Since the reference discloses ranges and materials, it would have been obvious to one of ordinary skill in the art to form a film within these ranges with desired size and quantity of microvoids. That the properties will vary within the disclosed ranges would have been expected by one of ordinary skill in the art....These modifications would have been obvious to one of ordinary skill in the art to achieve either of the results set forth above.”

The rejection is traversed for the reasons stated in Applicants’ previous response and the following additional arguments. Although Applicants agree that the present invention would have been obvious in view the present disclosure in combination with the prior art, the Examiner has not

satisfied the burden under 35 U.S.C. 103 that the invention would have been obvious in view of the prior art alone.

The fact that “the reference discloses ranges and materials,” does not mean that “it would have been obvious to one of ordinary skill in the art to form a film within these ranges with desired size and quantity of microvoids,” since the desired properties are only taught by the present disclosure. Accordingly, one wonders how the reference could have “desired” what Applicants invented without reading Applicants’ disclosure.

With similar logic, the Examiner argues that the necessary “modifications” to obtain Applicants’ invention “would have been obvious to one of ordinary skill in the art to achieve either of the results set forth above.” However, that argument begs the question of whether Morita et al. would have sought to achieve the results obtained by the present invention or whether Morita et al. would have known how to obtain the results of the present invention. Although Applicants agree that blindly varying each step of the process of Morita et al. would vary the resulting properties, merely changing properties or process steps in the prior art is not an adequate description or teaching of the present invention. The element of time and predictability is relevant on this issue. Based on the present inventors’ testimony, the present invention involved substantial time and surprise.

In view thereof, the teaching of Morita et al. to make a diaper would not render obvious the making of an inkjet recording element having the claimed inkjet recording properties. It follows that the subject matter of the claims would not have been obvious over Morita et al. at the time the invention was made.

Applicants have reviewed the prior art made of record and believe that singly or in any suitable combination, they do not render Applicants’ claimed invention unpatentable.

In view of the foregoing remarks and amendment, the claims are now deemed allowable and such favorable action is courteously solicited.

Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is

requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Konkol', written over a horizontal line.

Chris P. Konkol  
Attorney for Applicant(s)  
Registration No. 30,721

CPK:clb  
Rochester, NY 14650  
Telephone: (585) 722-0452  
Facsimile: (585) 477-1148